

REMARKS

Claims 1-17 were originally presented for examination. Applicants have amended claims 1, 7, 8, 11, 13, and 14, cancelled claims 15-17, and have added claim 18, as indicated above. Thus, claims 1-14 and 18 are now pending for examination. Applicants submit that no new matter has been introduced by reason of the amendments or new claim. Specifically, the amendments to claims 1 and 13 are supported by, for example, paragraph 0137 of Applicants' disclosure. The amendment to claim 8 is supported, for example, at paragraph 0133 of Applicants' disclosure. And new claim 18 is supported by, for example, paragraph 0012 of Applicants' disclosure. Reconsideration and allowance of all pending claims is requested.

35 U.S.C. § 101 REJECTIONS

The Patent Office rejected claims 1-17 as being directed toward non-statutory subject matter. The basis stated for this rejection is that the invention is not within the "technological arts" and that the invention produces no useful, concrete, and tangible result. Applicants respectfully traverse this rejection.

The Supreme Court has stated that "anything under the sun that is made by man" is patentable. *Diamond v. Chakrabarty*, 447 U.S. 303, 308-309 (1980). There are three categories of subject matter that are unpatentable: laws of nature, natural phenomena, and abstract ideas. *State Street Bank and Trust Co. v. Signature Financial Group Inc* 149 F.3d 1368, 1373 (Fed. Cir. 1998). The M.P.E.P. states that non-statutory subject matter is limited to these three categories. See 2100-11. Applicants respectfully submit that the claimed invention does not fall into any of these three categories.

Applicants submit that claims 1-14 and 18 of the present invention qualify as a "process" under 35 U.S.C. § 101. Applicants respectfully submit that although the methods of claims 1-14 can be implemented using a computer or otherwise in certain embodiments, a process does not need to be computer implemented to be statutory. 35 U.S.C. § 101 (processes are patentable, with no distinction as to how implemented).

Applicants further submit that the present invention produces a "useful, concrete and tangible result" related to evaluation of work product. The usefulness of the

"numerical values" of original independent claims 1 and 13 would be clear to a person of skill in the relevant art(s). As an example, Applicants submit that the usefulness of the "numerical values" of original claims 1 and 13 would be clear to a person of skill in the technological art of evaluating the performance of financial advisors. However, to expedite prosecution of this case and to further illustrate that claims 1 and 13 cover statutory subject matter, Applicants have amended these claims to include the steps of compiling the results and providing the results to the financial advisor.

These new steps further highlight a concrete and tangible result which a person of ordinary skill in the art would recognize as being useful. For example, as stated in paragraph 0137 of Applicants disclosure, a financial advisor may use this feedback to improve his performance. This is "a useful, concrete and tangible result." As a person of skill in the relevant art(s) would recognize, the numerical value or results of claims 1 and 13 may be used for other purposes, such as removing incompetent financial advisors, allocating bonuses or raises to the best financial advisors, evaluating the need for additional training or supervision, or evaluating the performance of people who train or supervise financial advisors, and the like. Significantly, the specific analysis and determination of numerical values related to the advice is extremely unique and beneficial in the financial advising industry.

In addition, Applicants submit that the step of "providing said results to the financial advisor" of independent claims 1 and 13 is an "independent physical act" that puts these claims into a safe harbor for process claims as described in the M.P.E.P. at 2100-15 to -16. Thus, these claims, as amended, are clearly statutory.

As to system claim 15, the Patent Office also stated that it is not statutory subject matter because it produces no useful, concrete, and tangible result, and because the numerical values generated reflect subjective human judgment rather than objective criteria. Applicants submit that although the evaluation of written work product is inherently subjective to some degree, that a purpose and result of many embodiments of the present invention is to make such an evaluation less subjective. In any event, subjectivity in ratings does not render an invention non-statutory. 35 U.S.C. § 101 (does not address subjectivity). Applicants submit that an evaluation system used to measure written work-product would be useful to a person engaged in the art of evaluating written work product. Further, Applicants submit that the rating and

numerical value of claims 1 and 13 provides as concrete and tangible a result as practicable for evaluation of written work product.

Applicants respectfully submit that the pending claims cover statutory subject matter. Reconsideration of all pending claims is requested.

35 U.S.C. § 112 REJECTIONS

The Patent Office rejected claims 15-17 as being indefinite because they claimed a system without suggesting any "apparatus structure or computer and therefore cannot be a system as disclosed in the preamble." Without consenting to this rejection, but responsive thereto, Applicants have cancelled claims 15-17 without prejudice or disclaimer. Applicant submit that the rejection of claims 15-17 is now moot.

35 U.S.C. § 103 REJECTIONS

The Patent Office rejected claims 1-14 and 17 as being obvious over US 5,909,669 (Havens) in view of 5,696,907 (Tom). Applicants respectfully traverse this rejection as Applicants submit that the references cited do not teach or suggest all of the claim limitations. Regarding independent claim 1, Applicants submit that neither reference teaches or suggests the step of "reading a case prepared by the financial advisor, wherein said case provides recommendations", as recited in claim 1. Havens teaches surveying workers, peers, supervisors, etc. (e.g., col. 4, lines 20-41, and col. 11, lines 39-49), but does not teach or suggest reading a particular case prepared by anyone, let alone a financial advisor.

Tom also does not teach or suggest "reading a case prepared by the financial advisor" as recited in claim 1. First, Tom does not teach or suggest "reading a case" prepared by anyone. Second, the "credit manager" of Tom is not the same as the "financial advisor" of the present invention. The "financial advisor" of the present invention is a person who provides financial advice to a client. See, for example, paragraph 0018 of Applicants disclosure. In contrast, the "credit manager" of Tom is a person who receives financial service applications and evaluates information to make

decisions regarding business expansion and the like (col. 2, lines 19-24). Thus, Tom does not teach or suggest the financial adviser required in claim 1.

Similarly, independent claim 13 contains the limitation "selecting a case prepared by the financial advisor". Applicants submit that the cited references do not teach or suggest this limitation. In addition, independent claims 1 and 13 may contain other limitations not taught or suggested by the prior art of reference.

Further, applicants submit that the claims that are dependent on claim 1 or on claim 13, either directly or indirectly, are allowable because they are dependent on an allowable base claim. Applicants submit that these dependent claims may contain other elements that further distinguish them from the cited references.

CONCLUSIONS

Applicants submit that the pending claims are allowable over the prior art of record. Reconsideration and allowance of all claims is earnestly solicited. Further, the Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions or such a conversation may facilitate allowance of the present application.

Respectfully submitted,

Date: _____

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By: _____



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